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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,139	05/23/2000	Paul Lapstun	NPA019US	9190

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2626

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,139

Applicant(s)

LAPSTUN ET AL

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 14, 2005 has been entered.

Applicant amends claims 25, 36.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al (US Patent No. 5,848,426) in view of Lemelson (US Patent 3,918,029).

Concerning claim 36, Wang discloses a system (Fig. 1 or 2) to enable a user to compose and deliver a message by facsimile, utilizing a form printed on at least one paper surface, the form including information relating to the user and at least one area for the user to enter the message, the at least one paper surface having coded data indicative of an identity of the form and of the at least one area (Fig. 7), the system including a computer system (4, 6) which causes

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the form to be provided to the user, receives the interaction data from a sensing device (2) used to compose the message, the interaction data being indicative of an identity of the form (Figs.4-6), wherein the sensing device, when placed operatively relative to the area in order to compose the message, generating the interaction data based at least partially on sensing at least some of the coded data in the vicinity of the position, and captures the message to be transmitted to a designated recipient address by facsimile delivery.

Wang does not directly teach that the interaction data is indicative of a position of the sensing device relative to the area on the paper surface. However, Wang teaches in Fig.6 a view of a portion of the image code 16 (Fig.5) having a start pattern, left row indicator, right row indicator, stop pattern that are equivalent to the position of the sensing device when it scans the image code 16. In addition, Lemelson discloses a scanning system connected to a plurality of communication system that can easily locate a coded printed on a record member and provide for guiding the implement in a fixed path across a record member such that a coded track thereof is photo-optically scanned by the implement (Abstract). Lemelson teaches that, in sheet 10, a start code such as 105 for initiating, when scanned, playback or gating of the associated coded information and a terminating code such as 106 for effecting the reproduction or gating of just the information which the operator desired to reproduce (col. 19, line 26 – col. 20, line 33). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of information data indicative of a position of the sensing device relative to the area on the paper surface taught in Lemelson to the interaction data in Wang since both the scanner in Wang and Lemelson teach a computer receiving the interaction data from a sensing device

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wherein the interaction data represent a position of the sensing device relative to the area on the paper surface.

Concerning claim 37-41, 43, 47, 48, Wang further teaches that the computer system causes the form to be provided to the user in response to receiving a request for the form (col. 5, lines 24-33), (claim 37); the computer system causes both the form and the coded data to be printed onto the at least one surface substantially simultaneously (Figs 7-12), (claim 38); the computer system is adapted to deliver the message with a reply number, valid for a predetermined time (col. 8, lines 6-29), (claim 39); the computer system includes a fax application for receiving and formatting the message for transmission to a fax system, the fax application further serving to allocate the reply number (Figs 1-2; col. 5, lines 16-33; col. 6, lines 8-26), (claim 40); the computer system includes the reply number dependent upon a sender's instruction, indicated by interaction of the sensing device with an appropriate user interactive element on the form (col. 6, lines 8-26; col. 8, lines 6-33), (claim 41); the system includes the sensing device (2), (claim 43); the system includes a database (6) for keeping a retrievable record of each form printed, each record being retrievable by using at least some of the coded data on the at least one surface on which the form is printed (col. 5, lines 18-28; col. 6, lines 8-11; col. 7, lines 15-20), (claim 47); the system includes a printer (8) for printing at least the form onto the at least one surface (claim 48).

Concerning claims 42, 44, 45, 46, Wang fails to teach that the computer system is adapted to receive movement data regarding movement of the sensing device relative to the form, in order to capture the message and the sensing device includes a marking nib, wherein the coded data is substantially invisible to the average unaided human eye. Lemelson teaches that

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the computer (37) can receive movement data regarding movement of the sensing device (32) relative to the form (10) wherein the sensing device generates the movement data using at least some of the coded data, (col. 4, line 66 – col. 5, line 19; col. 9, line 13 – col. 60; col. 19, line 26 – col. 20, line 33). Lemelson further teaches that the coded data is substantially invisible to the average unaided human eye (col. 6, line 35 – col. 7, line 1). It would have been obvious to one skilled in the art at the time the invention was made to combine the above teachings of Lemelson to the computer system in Wang since Wang also teach the sensing device 2 that can scan a form with markings or image code for transmission to communication lines.

Concerning claim 49, Wang fails to teach that the printer includes a binding means for binding the printed form in the event the form includes a plurality of pages. However, it was a matter of well known in the art at the time the invention was made to have a printer with a binding means for binding a plurality of pages. It would have been obvious to one skilled in the art at the time the invention was made to consider the printer 8 in Wang having a binding means for binding a document having a plurality of pages as a matter of well known in the prior art since Wang teaches that the form can have a plurality of the pages and Wang does not limit the printer 8 to a specific printer type or model.

Claims 25-35 are method claims of apparatus claims 36-49. Claims 25-35 are rejected for the same rationales set forth for claims 36-49.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a. Morita et al (US Patent No. 6,885,769) discloses a business form handling method and system including an image reading device for reading a business form and a terminal apparatus for discriminately deciding the species of the business form.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday, Tuesday, Thursday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Madeleine AV Nguyen
Primary Examiner
Art Unit 2626

June 22, 2005